



## UNITED STATES DEPARTMENT OF COMMERCE

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08/081,183 06/25/93 UEDA

18M2/0324

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T EXAMINER

WILSON, J

ART UNIT

PAPER NUMBER

11

1803

DATE MAILED:

03/24/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS This application has been examined  Responsive to communication filed on Nov. 1, 1994  This action is made final.A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474..
6.  \_\_\_\_\_

## Part II SUMMARY OF ACTION

1.  Claims 1 - 10 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.3.  Claims \_\_\_\_\_ are allowed.4.  Claims 1 - 10 are rejected.5.  Claims \_\_\_\_\_ are objected to.6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.7.  This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.8.  Formal drawings are required in response to this Office action.9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.14.  Other

08/081,183

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

Please note that applicant's offer to surrender the original patent has been duly noted. However, in the absence of the original patent, applicants must be reminded that the instant reissue application should have been accompanied by the original patent, or if the original patent is lost or inaccessible, by an affidavit or declaration to that effect. The instant reissue application has been accepted for examination in the absence of the original patent or the declaration or affidavit, however, applicants are reminded that one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

This application is objected to under 35 U.S.C. § 251 as lacking the written consent of all assignees owning an undivided interest in the patent.

Presently, it is unclear whether the individuals signing the Consent of Assignee to file the Reissue Application 08/081,183 have authority to take action in the instant 08/081,183 by clearly establishing on the record ownership of the property. Ownership is established by submitting to the office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g. reel and frame number, etc.) where such evidence is recorded in the office. It is noted that no title has been provided for either of the individuals who have signed the Consent of Assignee to filing the reissue application document submitted October 4, 1993.

Please note that the statement by the assignee may be signed by any person if the statement includes an averment that the person is empowered to sign the statement on behalf of the assignee. If not signed by a registered practitioner, the statement including the averment must be in oath or declaration form (please see M.P.E.P. 324).

The reissue declaration filed with this application and the subsequently filed supplemental reissue declaration are defective because they fail to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(3) and the reissue declaration and the subsequently filed supplemental reissue declaration filed with this application are defective because they fail to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

The reissue declaration is defective for the reasons set forth herein below.

It is noted that the reissue declaration filed October 4, 1993 fails to specifically address the specific "error" necessitating the addition of claims 9 and 10. The reissue declaration fails to specifically address how and when "error" arose or occurred, how and when "error" was discovered, and how the amendment specifically adding claims 9 and 10 overcomes said "error". It is noted that the reissue declaration fails to address how the addition of claims 3-8 overcomes "error".

The reissue declaration also fails to adequately address

changes made to the specification and the abstract. Please note that each and every change in the specification must be supported in either the original declaration or a supplemental declaration. Every departure from the original patent represents an "error" in said original patent under 35 U.S.C. 251 and must be particularly and distinctly specified and supported in the reissue declaration under 37 CFR 1.175, or in a supplemental reissue declaration.

The amendment filed October 4, 1993 to modify passages in the specification of the instant 08/081,183 is not in proper form. The proper manner of making amendments under 37 CFR 1.121 is clearly delineated in the MPEP 1453. Correction of the manner in which amendments to the original description are presented are improper. Correction for proper entry of amendments are respectfully requested.

The subsequently filed supplemental reissue declaration is defective for the reasons set forth herein below.

The supplemental reissue declaration filed November 1, 1994 fails to address the specific claims to which its content is drawn. The supplemental reissue declaration also fails to address the specific "error" necessitating the addition of claims 9 and 10. The reissue declaration fails to specifically address how and when "error" arose or occurred, how and when "error" was discovered, and how the amendment specifically adding claims 9 and 10 overcomes said "error". The reissue declaration fails to address how the addition of claims 3-8 overcomes "error".

It is further noted that applicant has deleted subject matter from the specification which must be specifically addressed in the supplemental reissue declaration. Likewise, changes specifically made to the Abstract should also be addressed in the supplemental reissue declaration. Please note that every departure from the original patent represents an "error" under 35 U.S.C. 251 and must be particularly and distinctly specified and supported in the original reissue declaration or in a supplemental reissue declaration.

The Supplemental Reissue Declaration submitted November 1, 1994 is defective because it is not properly signed and dated.

Please note that the reissue declaration and the supplemental reissue declaration appear to attempt to recapture information which was deliberately canceled in U.S. Application Serial No. 07/447,512 in order to obtain a patent, see Amendment filed October 18, 1990. A reissue will not normally be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent, see In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960), In re Richmond, 161 USPQ 359, 363, 364 (CCPA 1969); In re Wadlinger, Kerr and Rosinski, 181 USPQ 826 (CCPA 1974) (see MPEP 1412.02).

Claims 1-10 are rejected as being based upon a defective reissue declaration and a defective supplemental reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Please note that Claim 1 printed in U.S. Patent 5,026,835 is

not the claim allowed in the U.S. application 07/447,512. The error appears to be a mistake incurred through the fault of the Patent and Trademark Office as is disclosed by the records of the Office, see U.S. Patent Application 07/447,512, the Response (and amendment) submitted October 18, 1990, page 2, line 5. It is noted that the last line of the claim should read: "...except that both of R<sup>3</sup> and R<sup>4</sup> may not be hydrogen." as that is the language allowed in Claim 1 of allowed application 07/447,512.

A certificate of correction of Patent and Trademark Office mistake may be issued at the request of the patentee under 35 U.S.C. 254. Such a request will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording the patentee an opportunity to be heard. See also 37 CFR 1.322.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Art Unit 1803

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Wilson whose telephone number is (703) 308-4624 or to his immediate supervisor, Douglas Robinson, SPE 1803, whose telephone number is (703) 308-2897.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

James O. Wilson

  
DOUGLAS W. ROBINSON  
SUPERVISORY PATENT EXAMINER  
GROUP 1800